IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Mark Beckmann et al.
Serial No.:	10/522,345
Date Filed:	March 10, 2005
Group Art Unit:	2617
Confirmation No.:	6320
Examiner:	Patel, Nimesh
Title:	**METHOD AND DATA SYSTEM FOR CONNECTING A WIRELESS LOCAL NETWORK TO A UMTS TERMINAL STATION**

MAIL STOP – AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Application has been carefully reviewed in light of the Final Office Action mailed July 19, 2010 ("Final Office Action"). At the time of the Final Office Action, Claims 16-30 were pending, all of which were rejected. Claims 1-15 were previously cancelled without prejudice or disclaimer. No claim amendments are hereby requested. This Request is being filed concurrently with a Notice of Appeal.

ARGUMENT

Independent Claims 16, 23, and 30 are Allowable.

Independent Claims 16, 23, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Reddy* (U.S. Patent Publication No. 2004/0043791) in view of *3GPP* (3GPP TS 31.111 version 4.5.0 Release 4, 2001-12).

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicants traverse the rejections of Claims 16, 23, and 30 based on *Reddy* and *3GPP*, as discussed below.

First, the Examiner acknowledges that Reddy does not teach "polling the terminal station, by a universal chip card installed in the terminal station, for specific subscriber data of the wireless local network for the logical connection." (Office Action, page 6). Rather, the Examiner alleges that *3GPP* teaches this limitation. According to the Examiner:

The technical specification 3GPP TS 31.111 version 4.5.0 Release 4, Dec. 2001 teaches, once the ME has made its attempt to execute a proactive command from the UICC, the ME shall inform the UICC of the success or otherwise of that command, by using TERMINAL RESPONSE. This message gives the command details, including the number of command, a general result and sometimes more specific information (Section: 6.7). It also teaches, ME informs UICC for NO SERVICE is currently available, NO radio resource currently available. The provide local information command requests the ME to send current local information to the UICC, this information includes the Mobile Country Code MCC, mobile network code MNC, location area code LAC and cell ID of the current serving cell, the IMEI of the ME, the network measurement results and the BCCH channel list, the current date, time and time zone etc., (Section 6.4.15).

(Final Office Action, pages 6-7).

Applicants respectfully disagree with the Examiner's reasoning. *3GPP*'s teaching of the ME informing the UICC that "NO SERVICE is currently available" or "NO radio resource currently available" (*3GPP*, Section 6.7) indicates that the UICC is not "*polling the terminal station ... for the logical connection.*" Further, "NO SERVICE" and "NO radio resource currently available" clearly indicate that the communication is not made with respect to a detected activity or connection, as in Applicants' claimed invention. Obviously, a "NO SERVICE" and "NO radio resource currently available" indicates there is no logical connection, and thus clearly cannot read on "initiating a logical connection between the wireless local network and the terminal station; and polling the terminal station, by a universal chip card installed in the terminal station, for specific subscriber data of the wireless local network for the logical connection," as recited in claim 1.

Further, with respect to the "Local Information" disclosed in *3GPP*, Section 6.4.15, one of ordinary skill in the art would recognize that the specific items of "Local Information" are the items of information mentioned *during the establishment of the connection*, not *after the connection is established* (e.g., for monitoring the established connection or for cleardown of an established connection).

Even further, the specific items of "Local Information" listed in *3GPP*, Section 6.4.15 are not "*specific subscriber data*." There is no indication that any of such data is specific to the particular subscriber. *3GPP* does not teach the UICC polling the ME for "*specific subscriber data*," much less where such polling is done in response to a logical connection initiated between the wireless local network and the terminal station.

For at least the various reasons set forth above, Applicants respectfully submit that even if *Reddy* could be combined with *3GPP* (which Applicants do not concede), the resulting system would still fail to teach or make obvious all features of amended Claim 16.

Thus, Applicants respectfully submit that amended Claim 16 is clearly distinguished from *Reddy* and *3GPP*. Accordingly, Applicants request reconsideration and allowance of amended Claim 16, as well as all claims that depend therefrom. Also, for similar reasons, Applicants request reconsideration and allowance of amended independent Claims 23 and 30, as well as all claims that depend therefrom.

All Dependent Claims are Allowable.

Dependent Claims 17, 19-22, 24, and 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Reddy* in view of *3GPP*.

Dependent Claims 18 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Reddy* in view of *3GPP* and further in view of *Le* (U.S. Patent No. 6,556,820).

All dependent claims are allowable at least because they depend from the independent claims shown to be allowable. Further, *Le* fails to teach the features not taught by *Reddy* and *3GPP*. Thus, for at least these reasons, Applicants submit that all pending dependent claims are allowable.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants submit this Argument in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants authorize the Commissioner to charge Deposit Account No. 50-4871 in the amount of **$540** for the Notice of Appeal fee, as well as **$130** for a one-month extension, to Deposit Account 50-4871 in order to effectuate this filing.

Applicant believes there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-457-2031.

Respectfully submitted,
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